

## Remarks

### In the Specification

The top portion of page 16 of the specification is amended to correct an obvious typographical error. The formulae toward the end of the first full paragraph of page 16 now read:

$$\bar{L} \pm \frac{1}{2} \bar{L} \text{ instead of } L \pm \frac{1}{2} \bar{L}$$

and

$$\bar{L} \pm \frac{1}{4} \bar{L} \text{ instead of } L \pm \frac{1}{4} \bar{L}.$$

Support is found in the parenthetical example of the paragraph immediately following  $L \pm \frac{1}{2} \bar{L}$  "(for example, in the case of an average particle size of 0.2  $\mu\text{m}$ ,  $0.2 \pm 0.1 \mu\text{m} = 0.1$  to  $0.3 \mu\text{m}$ )".

$\bar{L}$  is defined as the average particle size earlier in the paragraph. In the example, 0.2  $\mu\text{m}$  is the average particle size and appears in the example formula in the position of L. Applicants respectfully suggest that it is clear from this example that  $\bar{L} = \text{average particle size} = L$  and that the amendment is fully supported by the specification.

### In the Claims

During the prosecution of the instant application a series of relatively minor errors have been made by Applicants' agent including mislabeling claims etc. In order to rationalize further prosecution, and remove the potential for the propagation of any of the earlier formal errors, the existing claims have been cancelled and replaced by a new set of claims which correlate to the earlier 34 claims in content and wording, except where noted below, plus one additional claim, number 69. Claims 66-68, correspond to now cancelled claims 31-34 which were present in Applicants' previous amendment but overlooked by the Examiner.

Claims 1-34 were pending.

Claims 1-34 are cancelled.

Claims 35-69 are new.

The application now contains claims 35-69.

Claims 35-68 are correspond to claims 1-34 as amended in Applicants' amendment of August 4, 2005, i.e., cancelled claim 1 corresponds to new claim 35, cancelled claim 2 corresponds to new claim 36 and so on. Several objections and 35 USC 112 rejections were noted by the examiner in the most recent office action and the appropriate corrections, as detailed below, are incorporated. The claim dependencies were also corrected and modified. Support for the new claims 35-68 resides therein. No new matter is added.

Support for new claim 69 is found in the specification in the last paragraph on page 11.

No new matter is added.

#### Claim objections

Now cancelled claims 18 and 29 were objected to for misspelling and claim 20 was objected to for redundant use of the word step. The word "selected" is correctly spelled in new claims 52 and 63 and the redundant word is removed in claim 54.

#### Claim rejections

Claims 15, 27-28 and 30-31 were rejected under 35 USC 112 second paragraph as the term "L" was not clearly defined. In corresponding claims 49, 61-62 and 64-65 "L" has been replaced with " $\bar{L}$ " which is identified on page 16 as the average particle size of the pigment. As explained above in the remarks regarding amendments to the specification, this was a typo and the correction is supported in the specification in the parenthetical example of the first full paragraph.

Claim 19 was rejected under 35 USC 112 second paragraph as the term "the media" lacked appropriate antecedent basis. In corresponding new claim 53, "the media" has been replaced with "the organic liquid and water".

Claim 23 was rejected under 35 USC 112 second paragraph as the term "the pigment surface" lacked appropriate antecedent basis and "washing agent" was not mentioned in the parent claim. Both terms are removed from corresponding claim 57. The phrase "organic liquid or water" near the end of claim 23 is changed to "organic liquid and/or water" in new claim 53.

Claims 1-31 were rejected under 35 USC 103(a) as being unpatentable over Giger, et al., U.S. Pat. No. 6,890,380. As stated by the Examiner in the Office Action, Giger qualifies as prior art only under 35 USC 102(e).

The presently claimed invention and U.S. Pat. No. 6,890,380 were, at the time the invention was made, entirely assigned to Ciba Specialty Chemicals Corp. or were subject to an obligation of assignment to Ciba Specialty Chemicals Corp.

The assignment of U.S. Pat. No. 6,890,380 was recorded in the USPTO October 29, 2003 reel/frame 014633/0064.

The assignment of the present application was recorded in the USPTO January 31, 2005, reel/frame 016205/0039.

The 35 USC 103(a) rejections as applied to 35 USC 102(e) are overcome as the present application and cited Giger patent are commonly assigned to Ciba Specialty Chemicals Corp.

Attached also is a terminal disclaimer to overcome the obviousness-type rejection of claims 1-31 over US 6,890,380. Applicants' assume that the same rejection would have been made for the newly presented claims.

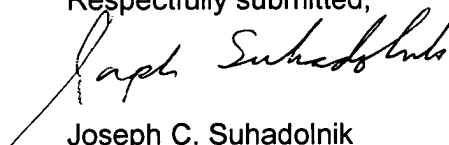
Miscellaneous changes

The only other changes made in the new claims are that claims 53, 54 and 68 (corresponding to 19, 20 and 24) depend from different corresponding base claims and claim 65 does not contain the limitation "the liquid media is at a pH in the range of from 9-11" found in corresponding claim 31.

Applicants respectfully suggest that the new claims and other statements obviate all preceding objections and rejections and kindly ask that the Examiner find them allowable. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Ciba Specialty Chemicals Corporation  
Patent Department  
540 White Plains Road  
P.O. Box 2005  
Tarrytown, NY 10591-9005  
Tel. (914) 785-2973  
Fax (914) 785-7102

Respectfully submitted,



Joseph C. Suhadolnik  
Agent for Applicants  
Reg. No. 56,880  
filed under 37 CFR 1.34(a)

**DEC 22 2005**